

29 JAN 2007



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In re Application of

Jallouli et al.

Application No.: 10/540,176

PCT No.: PCT/EP03/15046

Int. Filing Date: 19 December 2003

Priority Date: 20 December 2002

Attorney Docket No.: ESSR:094US

For: Spirotetrathiocarbamates And
Spirooxothiocarbamates

DECISION

ON

PETITION

This is in response to the petition under 37 CFR 1.47(a) filed on 04 April 2006.

BACKGROUND

This international application was filed on 19 December 2003, claimed an earlier priority date of 20 December 2002, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 08 July 2004. The 30 month time period for paying the basic national fee in the United States expired at midnight on 20 June 2005. Applicants filed *inter alia* the basic national fee on 17 June 2005.

On 07 December 2005, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration compliant with 37 CFR 1.497(a) and (b), and indicating that the "4th inventor signature missing (Declaration filed under PCT Rule 4.17)."

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding requirement (1), applicants paid \$130.00 toward the petition fee on 04 April 2006. The balance of \$70.00 is being charged to counsel's Deposit Account No. 50-1212, as authorized by the "Response To Notification Of Missing Requirements..." filed on 04 April 2006.

Regarding requirement (2), petitioner urges that the absence on the declaration of the signature of joint inventor Sirisoma Wanigatunga be excused because of he allegedly refused to sign the declaration. Counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor

is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal. When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Counsel refers to the accompanying "Declaration of Mark B. Wilson" as evidence of the circumstances surrounding the alleged refusal to execute this patent application. Atty. Wilson refers, *inter alia*, to a letter mailed to the inventors on 03 October 2005 (Exhibit 1), but that letter does not indicate that it was accompanied by a complete copy of the instant application. Petitioner also refers to e-mail correspondence dated 15 December 2005 (Exhibit 4) in which Dominique Jeannin states that "I do not expect him to sign any paper." Exhibit 4 is not persuasive because Mr. Jeannin is in essence making a conclusory statement about the mental state of Mr. Wanigatunga without providing a showing as to his basis for making the conclusion.

With regard to Exhibits 8 and 9, these Exhibits tend to show that an e-mail was sent to Mr. Wanigatunga and delivered to his in-box on 09 January 2006. Though Atty. Wilson's e-mail alludes to "attached documents," it does not clearly indicate that a complete copy of this particular patent application and a declaration directed thereto were attached. Therefore, Mr. Wanigatunga's alleged failure to reply to this e-mail as requested does not show that he refused to sign and return a declaration directed to this application after being presented with a complete copy of the application.

Turning to Exhibit 5, Atty. Wilson has provided a copy of a letter addressed to Mr. Wanigatunga at his last-known residential address. The letter itemizes *inter alia* a "complete copy of U.S. Serial No. 10/540,176 as filed June 17, 2005," as well as a declaration document. In the letter, Atty. Wilson requests that Mr. Wanigatunga execute and return the declaration document. Exhibits 6 and 7 constitute a showing that Federal Express delivered the correspondence to Mr. Wanigatunga's address on 10 January 2006. According to paragraph 15 of Atty. Wilson's Declaration, "As of the date of the execution of this Declaration, I have received no correspondence from Sirisoma Wanigatunga" as of 04 April 2006. On the basis of this showing, it would be appropriate to conclude that Mr. Wanigatunga's failure to execute and return the declaration sent to him on 09 January 2006 constitutes a "refusal" within the meaning of 37 CFR 1.47(a).

Regarding requirement (3), the petition includes a statement of the last known address of Sirisoma Wanigatunga. Accordingly, requirement (3) has been satisfied.

Regarding requirement (4), the declaration filed on 04 April 2006 has been signed by joint inventors Aref Jallouli, Martin Rickwood and Kimberly Morgan on behalf of themselves and non-signing joint inventor Sirisoma Wanigatunga. Said declaration is acceptable for purposes of compliance with 37 CFR 1.47(a) and 37 CFR 1.497(a) and (b). Therefore, requirement (4) has been satisfied.

DECISION

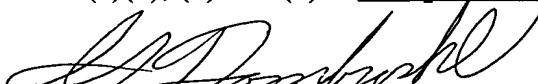
The petition under 37 CFR 1.47(a) is **GRANTED**.

The petition fee balance of \$70.00 is being charged to counsel's Deposit Account No. 50-1212.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

The application is being returned to the International Division for processing as the U.S. National Stage of the above-identified international application. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is 04 April 2006.



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01/29/2007 SBASHEIR 00000001 501212 10540176
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Adjustment date: 01/29/2007 SBASHEIR
04/07/2006 GFREY1 00000147 10540176
01 FC:1617 -130.00 OP